

REMARKS

The Office Action dated December 1, 2004 has been carefully reviewed. Claims 24-39 are currently pending. Reconsideration of the grounds of rejection is respectfully requested in view of the remarks herein.

Summary of the Office Action

References to paragraphs in the subject office action are referred to herein in parentheses identifying the appropriate paragraph, e.g. (para x).

Claims 24-39 have been rejected, under 35 U.S.C. § 103(a), as being unpatentable over Sergey in view of U.S. Patent No. 6,665,837, issued to Dean et al. ("Dean") (para 2).

Response to Office Action

A. Rejection of Claims 24-39

In response to the Examiner's rejection of claims 24-39, the Applicants respectfully assert that the pending claims are allowable over the cited references because the Examiner has failed to establish a *prima facie* case of obviousness. The MPEP states, in relevant part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP § 2142.

For the reasons discussed below, the Examiner has failed to establish a *prima facie* case of obviousness and claims 24-39 are patentable.

B. The Examiner has failed to show that Sergey and/or Dean, alone or in combination, teach or suggest all of the claim limitations of claims 24-39.

The Examiner has cited Sergey in combination with Dean for disclosing each and every element of claims 24-39. The Applicants respectfully disagree. As described by the Applicants in Amendment, dated July 26, 2004, Sergey describes Google's mechanism for single and multiple key word searching based on a query submitted by a user. In contrast, Dean describes a method for ranking related pages in a

linked database without using a query. Col. 3, lines 8-11. The ranking method uses content analysis and connectivity analysis starting “with a single Web page as input, rather than the result set produced by a search engine query.” Col. 3, lines 47-48; Col. 6, lines 62-64. A “Web neighborhood graph,” surrounding the initial selected Web page, is constructed based on the assumption that “related pages” are near the single Web page or that keywords, found in the initially selected page, also appear in the related pages. Col. 3, lines 60-63. The related pages are those that are linked to the initially selected web page by a defined number of links. Col. 4, lines 21-31. The graph contains “nodes” for the initial selected page and the related (or linked) pages. Col. 4, lines 14-16. The edges of the graph represent the hyperlinks between these pages. Col. 4, lines 16-17. Unrelated pages are eliminated by establishing a list of “stop” URLs that have a large number of links to many other web pages. Col. 4, lines 33-39.

1. Rejection of Claims 24, 30, 34 and 38

The method of claim 24 is comprised of the following steps: selecting a plurality of Web sites operated by content providers and relating to a category to which the specified subject relates; automatically determining the relevancy of at least one Web page in each selected Web site by scanning at least one Web page for words relating to the specified subject; automatically determining the content type of at least one Web page in each selected Web site by scanning at least one Web page for words indicating content type; compiling a list of relevant Web pages based on the results of steps (b) and (c), wherein the list of relevant Web pages includes only those Web pages that are determined both to be relevant in step (b) and to be of news content type in step (c) wherein the compiled list includes hyperlinks to the relevant Web pages; and providing the compiled list to the subscriber, wherein the subscriber is a party other than one of said content providers, wherein the providing comprises transmitting the compiled list from a Web server to the subscriber over the Internet. The Applicants respectfully submit that Sergey and Dean, alone or in combination, fail to teach the underlined features set forth in the above paragraph.

Regarding the claim 24 limitation of “compiling a list of relevant Web pages based only on the results of steps (b) and (c), wherein the list of relevant Web pages includes only those Web pages that are determined both to be relevant in step (b) and to be of news content type in step (c), wherein the compiled list includes hyperlinks to the relevant Web pages,” the Examiner has cited to Dean Col. 3, lines 38-50 and Col. 4, lines 16-20. The Applicants respectfully submit that Dean does not even mention the following limitations: compiling a list of relevant Web pages by scanning for words indicating subject and content type; the list of relevant Web pages includes only pages that are relevant and of news content; and a compiled list with hyperlinks to relevant web pages.

The Examiner cited Dean as disclosing a ranking method using “content analysis, as well as connectivity analysis.” Col. 3, lines 38-50. The content analysis, referred to in this section, is performed by “retrieval techniques” such as the Salton & Buckley model. Col. 5, lines 28-29. The cited passage of Dean does not even mention scanning a page for words related to content or a specified subject.

Furthermore, no section of Dean discloses a compiled list of relevant web pages including only web pages that are relevant and having news content.

Regarding the claim 24 limitation of “wherein the compiled list includes hyperlinks to the relevant Web pages,” the Examiner has cited to Dean Col. 4, lines 16-20 which states:

We use the initial page 201 to construct 210 a neighborhood graph (n-graph) 211 in a memory. Nodes 212 in the graph represent the initial selected page 201 as well as other closely linked pages, as described below. The edges 213 denote the hyperlinks between pages. The “size” of the graph is determined by K which can be preset or adjusted dynamically as the graph is constructed. The idea being that the graph needs to represent a meaningful number of pages. (underlining added for emphasis.)

The Applicants submit this passage of Dean describes the construction of a neighborhood graph which includes the initial selected web page and a subset of other web pages. Col. 3, lines 53-54. A node represents the initially selected web and related web pages while an edge represents the hyperlinks between the web pages. Col. 4, lines 16-20. The neighborhood graph of Dean is not the same as a

compiled list of web pages having hyperlinks to other web pages wherein the compiled list was assembled by scanning a page for words for content type and subject type.

Therefore, Dean does not disclose, teach or suggest step (d) of claim 24 nor does Sergey make up for the deficiency as admitted by the Examiner. The Applicants respectfully submit that Sergey and Dean fail to show, either alone or in combination, all of the claim limitations of claim 24. Likewise Sergey and Dean fail to show, either alone or in combination, all of the claim limitations of claims 30, 34 and 38 which include the same claim limitations as claim 24.

Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and claims 24, 30, 34 and 38 are patentable.

2. Rejection of Claims 25, 31, 35 and 39

Claim 25 is directed to a method of providing news relating to a specified subject to a subscriber. The method is comprised of the following steps: selecting a plurality of Web sites operated by content providers and relating to a category to which the specified subject relates; automatically determining the relevancy of at least one Web page in each selected Web site by scanning at least one Web page for words relating to the specified subject; automatically determining the content type of at least one Web page in each selected Web site by scanning at least one Web page for words indicating content type; compiling a list of relevant Web pages based on the results of steps (b) and (c), wherein the list of relevant Web pages includes only those Web pages that are determined both to be relevant in step (b) and not to be advertisements in step (c) wherein the compiled list includes hyperlinks to the relevant Web pages; and providing the compiled list to the subscriber, wherein the subscriber is a party other than one of said content providers, wherein the providing comprises transmitting the compiled list from a Web server to the subscriber over the Internet. The Applicants respectfully submit that Sergey and Dean, alone or in combination, fail to teach the underlined features set forth in the above paragraph.

As discussed above for claim 24, the Applicants respectfully submit that Dean does not even mention the following limitations: compiling a list of relevant Web pages by scanning for words indicating subject and content type; and a list with hyperlinks to relevant web pages.

The Applicants, furthermore submit that Dean does not disclose a list of relevant Web pages including only pages that are relevant and not advertisements. Dean does not even mention selecting web pages that are not advertisements.

Therefore, Dean does not disclose, teach or suggest step (d) of claim 25 nor does Sergey make up for the deficiency as admitted by the Examiner. The Applicants respectfully submit that Sergey and Dean fail to show, either alone or in combination, all of the claim limitations of claim 25. Likewise Sergey and Dean fail to show, either alone or in combination, all of the claim limitations of claims 31, 35 and 39 which include the same claim limitations as claim 25.

Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and claims 25, 31, 35 and 39 are patentable.

3. Rejection of Claims 26, 28, 32 and 36.

Claim 26 is directed to a method of providing news relating to a specified subject to a subscriber, comprising the steps of: selecting a plurality of Web sites operated by content providers and relating to a category to which the specified subject relates, wherein the plurality of Web sites is selected based on the frequency with which relevant links have been located in prior iterations of the method with respect to the specified subject; automatically determining the relevancy of at least one Web page in each selected Web site by scanning at least one Web page for words relating to the specified subject; automatically determining the content type of at least one Web page in each selected Web site by scanning at least one Web page for words indicating content type; compiling a list of relevant Web pages based on the results of steps (b) and (c), wherein the compiled list includes hyperlinks to the relevant Web pages; and providing the compiled list to the subscriber, wherein the subscriber is a party other than one of said content providers, wherein the providing comprises transmitting the compiled list from a Web server to

the subscriber over the Internet. The Applicants respectfully submit that Sergey and Dean, alone or in combination, fail to teach the underlined features set forth in the above paragraph.

As discussed above for claim 24, the Applicants respectfully submit that Dean does not even mention the following: compiling a list of relevant Web pages by scanning for words indicating subject and content type; and a list with hyperlinks to relevant web pages.

The Examiner has cited to Dean Col. 4, lines 22-32 for disclosing “wherein the plurality of Web sites is selected based on the frequency with which relevant links have been located in prior iterations of the method with respect to the specified subject.” This cited section of Dean, states:

During the construction of the neighborhood graph 211, the direction of links is considered as a way of pruning the graph. In the preferred implementation, with $K=2$, our method only includes nodes at distance 2 that are reachable by going one link backwards (“B”), pages reachable by going one link forwards (“F”), pages reachable by going one link backwards followed by one link forward (“BF”) and those reachable by going one link forwards and one link backwards (“FB”). This eliminates nodes that are reachable only by going forward two links (“FF”) or backwards two links (“BB”).

This section of Dean describes the construction of the neighborhood graph based on links between web pages. The web pages, indicated by nodes, are selected by a predefined number and direction of links from the initially selected web page. Col. 4, lines 15-16. The selection of web pages in the neighborhood graph is based on predefined linking criteria to the initially selected web page. Col. 4, lines 17-19. The Applicants submit this section of Dean has no mention of selecting relevant Web pages based on the frequency of locating the web page in prior iterations of the search for a specified subject.

Therefore, Dean does not disclose, teach or suggest step (d) of claim 26. Nor does it disclose, teach or suggest step (a) of claim 26. Nor does Sergey make up for the deficiency as admitted by the Examiner. The Applicants respectfully submit that Sergey and Dean fail to show, either alone or in combination, all of the claim limitations of claim 26. Likewise Sergey and Dean fail to show, either alone or in combination, all of the claim limitations of claims 28, 32, and 36 which include the same claim limitations as claim 26.

Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and claims 26, 28, 32 and 36 are patentable.

4. Rejection of claims 27, 29, 33 and 37

Claim 27 is directed to a method of providing news relating to a specified subject to a subscriber, comprising the steps of: selecting a plurality of Web sites operated by content providers and relating to a category to which the specified subject relates, wherein the plurality of Web sites is selected based on the frequency with which relevant links have been located in prior iterations of the method with respect to the same category; automatically determining the relevancy of at least one Web page in each selected Web site by scanning at least one Web page for words relating to the specified subject; automatically determining the content type of at least one Web page in each selected Web site by scanning at least one Web page for words indicating content type; compiling a list of relevant Web pages based on the results of steps (b) and (c), wherein the compiled list includes hyperlinks to the relevant Web pages; and providing the compiled list to the subscriber, wherein the subscriber is a party other than one of said content providers, wherein the providing comprises transmitting the compiled list from a Web server to the subscriber over the Internet. The Applicants respectfully submit that Sergey and Dean, alone or in combination, fail to teach the underlined features set forth in the above paragraph.

As discussed above for claim 24, the Applicants respectfully submit that Dean does not even mention the following: compiling a list of relevant Web pages by scanning for words indicating subject and content type; and a list with hyperlinks to relevant web pages.

As discussed above further for claim 26, the Applicants respectfully submit that Dean has no mention of selecting relevant Web pages based on the frequency of locating the web page in prior iterations of the search for the same category.

Therefore, Dean does not disclose, teach or suggest step (d) of claim 27. Nor does it disclose, teach or suggest step (a) of claim 27. Nor does Sergey make up for the deficiency as admitted by the Examiner. The Applicants respectfully submit that Sergey and Dean fail to show, either alone or in

combination, all of the claim limitations of claim 27. Likewise Sergey and Dean fail to show, either alone or in combination, all of the claim limitations of claims 29, 33, and 37 which include the same claim limitations as claim 27.

Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and claims 27, 29, 33 and 37 are patentable.

C. The Examiner has failed to show a motivation to combine Sergey with Dean

Even if Sergey and Dean disclose each and every element of claims 24-39, which they do not, the Applicants respectfully submit that there is not suggestion or motivation in either of Sergey or Dean or in the knowledge generally available to one of ordinary skill to make the proposed combination.

Independent claims 24-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sergey in view of Dean. Regarding claims 24, 30, 34 and 38, the Examiner states the motivation to combine Sergey and Dean as “being to enable the system provides (sic) a good ranking process to improve the ranking of pages in the search result so that just pages related to a particular topic are identified.” The Examiner’s statement is merely a conclusory statement stating a perceived advantage of the proposed combination. The Federal Circuit has repeatedly stated “that the determination of patentability must be based on evidence.” In re Sang-Su Lee, 277 F.3d 1338, 1345 (Fed. Cir. 2002). Furthermore, motivation to combine is a factual question and cannot “be resolved on subjective belief and unknown authority.” Id. at 1344. When an examiner resorts to use of general knowledge to find a motivation to combine “that knowledge must be articulated and placed on the record.” Id. at 1345. The Applicants respectfully submit the Examiner has not provided facts from either the references or general knowledge of the art to articulate a motivation to combine Sergey with Dean.

The Examiner, furthermore, has failed to identify a motivation to combine Sergey with Dean for claims 25-29, 31-33, 35-37 and 39. Motivation to combine references must be found either explicitly or implicitly in the references themselves or in the general knowledge of one skilled in the art. MPEP § 2143.01.

Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 24-39 and claims 24-39 are patentable.

D. Sergey and Dean are an improper combination as Dean teaches away from Sergey.

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, (Fed. Cir. 1983).

The Applicants respectfully assert that the combination of Dean with Sergey is an improper combination as Dean teaches away from Sergey. As discussed by the Applicants in an Amendment, dated July 26, 2004, Sergey discloses the mechanism of the Google search engine. In Figure 4, page 11, of Sergey, the query evaluation process is outlined. The steps, in part, are as follows: the query is parsed; words converted into wordIDs; the doclists is scanned until a document containing all the search terms is matched; and compute the rank of a document for the query.

In contrast, Dean does not start with or use a query. Dean states “we start with a single Web page as input, rather than the result set produced by a search engine query.” Col. 6, lines 63-64. Furthermore Dean states “because we start with a single Web pages, rather than the results of a query, we do not have an initial query against which to measure the relevance of the related pages.” Col. 7, lines 21-24.

The Applicants respectfully assert that Sergey and Dean are an improper combination because Sergey determines a web page’s relevance based on a search engine query while Dean teaches away from using the results of a query to measure relevance.

CONCLUSION

In view of the foregoing remarks, it is submitted that pending independent claims 24-39 are in condition for allowance. Accordingly, reconsideration and timely allowance of claims 24-39 are requested.

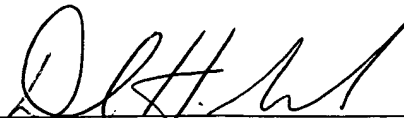
Applicants respectfully request reconsideration and withdrawal of the rejection based on 35 U.S.C. § 103(a) presented in the Office Action mailed December 1, 2004. The Examiner is invited to contact the undersigned at 215-963-5055 to discuss any matter concerning this Application.

The Commissioner is hereby authorized by this paper to charge any fees due in connection with the filing of the response to Deposit Account No. **50-0310**.

Respectfully submitted,

March 23, 2005
Date

By: _____



Daniel H. Golub
Reg. No. 33,701
Sharon B. McCullen
Reg. No. 54,303
MORGAN, LEWIS & BOCKIUS, LLP
1701 Market Street
Philadelphia, PA 19103-2921
Telephone: (215) 963-5055
Facsimile: (215) 963-5001